



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/678,636

10/06/2003

Peter Ernest Page

0730.0063C

7805

27896 7590 01/31/2007  
EDELL, SHAPIRO & FINNAN, LLC  
1901 RESEARCH BOULEVARD  
SUITE 400  
ROCKVILLE, MD 20850

EXAMINER

COY, NICOLE A

ART UNIT

PAPER NUMBER

3672

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
--	-----------	---------------

3 MONTHS

01/31/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/678,636	<b>Applicant(s)</b> PAGE ET AL.	
	<b>Examiner</b> Nicole Coy	<b>Art Unit</b> 3672	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 November 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213:

### Disposition of Claims

- 4) ☒ Claim(s) 92-106 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 92-106 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 November 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 92-102 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haeber (USP 3,256,937) in view of Hess (USP 5,404,946).

With respect to claim 92, Haeber discloses a method of completing a sub-sea well using a horizontal christmas tree for production flow control, the horizontal christmas tree having a body, the method comprising the steps of: forming an assembly by installing a completion string terminating at its upper end in and suspended from a tubing hanger in the body of christmas tree; and, running the assembly to the sub-sea well, the method characterized in that the tubing hanger and the horizontal christmas tree are above the water-line during the step of forming the assembly (see column 1 lines 61-65, wherein a tubing hanger would be present in order to connect the tubing to a Christmas tree).

Haeber is silent as to the type of christmas tree. It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Haeber by using a horizontal christmas tree in order to use less vertical space on both on the rig and in the well. Furthermore, Haeber does not disclose maintaining control of the well using at least two independently verifiable deep-set well control barriers. Hess teaches two independently verifiable deep-set well control barriers in order to control the movement

Art Unit: 3672

of borehole fluid at any desired depth within a borehole. It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Haeber by including two independently verifiable deep-set well control barriers, as taught by Hess, in order to control the movement of the borehole fluid.

With respect to claim 93, Haeber discloses the step of forming the assembly further comprises the steps of landing and locking the tubing hanger in the body of the christmas tree (wherein a tubing hanger would be present).

With respect to claims 94 –96, Haeber does not disclose the step of verifying the integrity of the completed assembly above the water line. However, it would have been obvious to modify Haeber in order to verify the integrity of the completed assembly in order to make sure that everything was working before running the assembly to its position on the ocean floor.

With respect to claim 97, Haeber does not disclose the step of running the assembly to the well head comprises the step of using a lower-riser package. However, lower-riser packages are well known in the prior art for running assemblies to the wellhead. It would have been obvious to one having ordinary skill in the art at the time of the invention to include a lower-riser package.

With respect to claim 98, Haeber discloses a method comprising: coupling a tubing string with Christmas tree above water, and landing the Christmas tree on a subsea wellhead (see column 1 lines 61-65). Haeber does not disclose maintaining control of the well using at least two independently verifiable deep-set well control barriers. Hess teaches two independently verifiable deep-set well control barriers in

Art Unit: 3672

order to control the movement of borehole fluid at any desired depth within a borehole. It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Haeber by including two independently verifiable deep-set well control barriers, as taught by Hess, in order to control the movement of the borehole fluid.

With respect to claim 99, Haeber discloses that coupling the tubing string with the Christmas tree comprises installing a tubing hanger on an uppermost joint of the tubing string and locking the tubing hanger to the Christmas tree (see column 1 lines 61-65; wherein in order to couple the tubing string to the tree requires a tubing hanger).

With respect to claim 100, Haeber discloses running the Christmas tree, the tubing hanger, and the tubing string open-water to a well extending from the subsea wellhead (see column 1 lines 61-65).

With respect to claim 101, Haeber discloses that running the Christmas tree, the tubing hanger, and the tubing string further comprises running the Christmas tree, the tubing hanger, and the tubing string without a blow-out preventer (see column 1 lines 61-65, wherein a BOP is not used).

With respect to claim 102, Haeber discloses that coupling the tubing string with the Christmas tree comprises installing a tubing hanger on an uppermost joint of the tubing string, locking the tubing hanger in the tubing spool, and attaching the tubing spool to the Christmas tree (see column 1 lines 61-65).

Art Unit: 3672

3. Claims 103-106 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bartlett (USP 7,063,157) in view of Hess.

With respect to claim 103, Bartlett discloses a method comprising: coupling a tubing string (50) with a tubing hanger (48) above water; landing the tubing hanger on a subsea wellhead (see figure 6 and column 4 lines 40-57); and landing a Christmas tree (22) on the subsea wellhead (see column 4 lines 58-67). Bartlett does not disclose maintaining control of the well using at least two independently verifiable deep-set well control barriers. Hess teaches two independently verifiable deep-set well control barriers in order to control the movement of borehole fluid at any desired depth within a borehole. It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Bartlett by including two independently verifiable deep-set well control barriers, as taught by Hess, in order to control the movement of the borehole fluid.

With respect to claim 104, Bartlett discloses latching the tubing hanger (48) to the Christmas tree (22) (see figure 11I).

With respect to claim 105, Bartlett discloses latching the tubing hanger (48) to the wellhead (20) (see column 6 lines 24-40).

With respect to claim 106, Bartlett discloses landing the tubing hanger (48) on the subsea wellhead (20) further comprises landing the tubing hanger on the subsea wellhead via a tubing spool and latching the tubing hanger to the tubing spool (see figure 11E, wherein the wellhead inherently has a tubing spool).

### ***Double Patenting***

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claim 98 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 17 of copending Application No. 11/474,314. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one having ordinary skill in the art at the time of the invention to suspend the completion string from the tubing hanger, as is conventional in the art.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Response to Arguments***

6. Applicant's arguments filed 11/14/06 have been fully considered but they are not persuasive. Applicant argues that it would not be obvious to modify Haeber or Bartlett to include to independently verifiable deep set control barriers. However, as noted above, Hess teaches two independently verifiable deep set control barriers. It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Bartlett and Haeber by including two independently verifiable deep-set well control barriers, as taught by Hess, in order to control the movement of the borehole fluid.

***Conclusion***

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of



Art Unit: 3672


the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicole Coy whose telephone number is 571-272-5405. The examiner can normally be reached on M-F 7:30-5:00, 1st F off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bagnell can be reached on 571-272-6999. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

nac

  
FEB 23 2011